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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,724	03/15/2004	Hansjorg Ander	3868-0156P	2073
2292	7590	07/18/2006	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			DESAI, ANISH P	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/799,724	Applicant(s) ANDER ET AL.	
	Examiner Anish Desai	Art Unit 1771	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The applicant's arguments in response to the Office action dated 01/20/2006 have been fully considered.

1. Claims 1-20 are cancelled. Claims 21-37 are newly added claims.
2. Foreign priority documents are received and accepted.
3. The newly submitted Oath/Declaration is accepted.
4. Objection to claims 15-18 is considered moot in view of the claim cancellation.
5. 112 rejections of claim 18 are moot because claim 18 is cancelled.
6. The rejection of claims 14-20 in view of Wembeke et al. (US 5,741,014) and Bonk et al. (US 4,731,273) are moot because claims 14-20 are cancelled.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 29, 36 and 37 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 29 contains the trademark/trade names Irgacure and Doracure. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used

properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe "radiation-sensitive initiator" and, accordingly, the identification/description is indefinite.

Claims 36 and 37 provide for the use of the pressure sensitive adhesive materials, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 36 and 37 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

In this application, claim 21 recites, "material can be produced by polymerization of a polymerizable mass comprising at least one compound selected from the group consisting of", however it is unclear as to what is the composition of the FINAL product (i.e. polymerized material)? The applicant is respectfully directed to define the composition of the material comprising polymerized mass. For the purpose of the examination, any reference disclosing a single species as disclosed in the claim 21 will read on the claim 21. Additionally the recitation "produced by polymerization of a polymerizable mass" is related to a product by process limitation. Note that the products by process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. "Even though product by process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product by process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 227 USPQ 964, 966 (Fed. Cir. 1985). Once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the

burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 289, 292 (Fed. Cir. 1983).

8. Claims 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Woods (US 4,414,275).

Woods teaches a flexible adhesive tape that can be used as sealants (column 2, lines 53-54). Further the tape of Woods comprises acrylate monomers such as isobornyl methacrylate (column 4, lines 60-62). The tape of Woods necessarily has a three dimensional structure and a defined cross-sectional contour.

9. Claims 21,23, and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Ono et al. (US 5,326,605).

Ono teaches reactive pressure sensitive adhesive composition comprising acrylic pressure sensitive adhesives. Further the pressure sensitive adhesive composition of Ono is useful as a sealer tape (abstract). The pressure sensitive adhesive of Ono comprises 2-hydroxyethyl methacrylate (column 3, lines 67-68). Note that the sealer tape of Ono necessarily has a three dimensional structure and a defined cross-sectional contour. Further Ono teaches that pressure sensitive adhesive comprises pigments (column 4, lines 22-25) in the amount of 1 to 60 parts by weight (column 4, lines 28-29).

10. Claims 21,24, 26, and 27 are rejected under 35 U.S.C. 102(b) as being anticipated by Komiyama et al. (US 5,118,567).

Komiyama teaches an adhesive tape comprising a methacrylate polymer, and an epoxy resin (abstract). Further, Komiyama teaches vinyl acetate at column 3, lines 39-

40. Additionally, Komiyama discloses glycidyl methacrylate (column 3, lines 25-26) and epoxy resin based on bisphenol A (column 3, lines 60-63). Note that the adhesive tape of Komiyama necessarily has a three dimensional structure and a defined cross-sectional contour.

11. Claims 21 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Doss (US 4,113,914).

Doss teaches a sealant composition comprising epoxy resin, a modifying resin and a hydrocarbon block copolymer (column 1, lines 4-7). Further Doss teaches styrene monomer (column 2, lines 44-45). Further Doss teaches that fluid sealant composition is applied to the area and wherein the sealant thereafter is cooled to generate solid sealing. Note the solid sealant necessarily has a there dimensional structure and a defined cross-sectional contour. The applicant has broadly recited "three-dimensional structure" and "a defined cross-sectional contour" without explicitly specifying any dimension of the sealing material or a shape of the cross-sectional contour, therefore the solid sealant of Doss anticipates the three-dimensional structure and has a defined cross-sectional contour.

12. Claims 21, 23, 27, and 31 are rejected under 35 U.S.C. 102(b) as being anticipated by Kinzer et al. (US 5,599,622).

Kinzer teaches a stabilized heat curable adhesive (abstract) comprising epoxy acrylate curable compositions, which comprises flame retardants (column 3, lines 8-15). Further the methacrylate comprises pentaerythritol tetramethacrylates (column 3, lines 66-67). Further the adhesive of Kinzer has physical properties of pressure sensitive

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adhesive (column 2, lines 42). Klinzer discloses claimed invention except the 0.1 to 10% wt of flame proofing agent, however since the concentration is recognized as a result effective variable, in absence of showing any criticality of the claimed amount of flame proofing agent, it is reasonable to presume that one can choose the amount of flame proofing agent, motivated by the desired to provide desired flame proofing capacity to the adhesive composition.

13. Claims 21, 28-30, and 33-35 are rejected under 35 U.S.C. 102(b) as being anticipated by Bonk et al. (US 4,731,273).

Bonk teaches a heat-recoverable closure with a crosslinked pressure-sensitive adhesive (PSA) is provided (abstract). The PSA of Bonk comprises dimethacrylate (column 5, line 43). Further, the PSA of Bonk necessarily has a three-dimensional structure and a defined cross-sectional contour (Figure 1). Regarding claim 28, Bonk teaches particular techniques of polymerization are disclosed in US Pat 4,181,752. The US Pat 4,181,752 discloses 0.01 to 5 parts of a photoinitiator (column 4, lines 7-8). Regarding claim 29, Bonk teaches the monomer mixture can be also polymerized with conventional peroxide initiated solution polymerization technique (column 6, lines 26-27). With respect to claim 30, Bonk teaches that it has been found desirable to incorporate in the adhesive composition reinforcing filler such as metal oxide (column 7, lines 48-53) in the amount of about 2% to about 7% by weight (column 7, lines 59-60). Regarding claim 33, Bonk teaches crosslinking agent in an amount of from about 0.8% to about 10% by weight (column 3, lines 7-8). With respect to claim 34, the PSA of

adhesive has semicircular cross-sectional contour (Figure 1). Regarding claim 35, the PSA of Bonk is in the form of continuous material (Figure 1).

Response to Arguments

Applicant's arguments with respect to claims 14-20 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

APD

Hai Vo

HAIVO
PRIMARY EXAMINER